



#14/Appeal
Brief

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Frank W. Liebenow)
Serial No.: 09/440,243)
Filed: November 15, 1999)
For: METHOD AND)
APPARATUS FOR)
MODIFYING AND)
CONTROLLING PRINT)
INFORMATION)

Examiner: Eugene Eickholt
12-17-02
L. Spruill
Group Art Unit: 2854
Docket: 450.264US1

APPELLANTS' BRIEF ON APPEAL

Box AF
Commissioner for Patents
Washington, D.C. 20231

Sir:

This brief is presented in support of the Notice of Appeal mailed November 12, 2001, and received by the PTO mail room on December 27, 2001, from the Final Rejection of claims 1 - 30 of the above identified application, as set forth in the Final Office Action mailed June 12, 2001. Thirty claims remain for consideration.

The Appeal Brief is filed in triplicate. Please charge the requisite fee of \$320.00 as set forth in 37 C.F.R. §§ 1.17(c) to Deposit Account 50-0439. Appellant reserves the right to submit a request for an oral hearing at a later time. Although other fees are not expected, Appellant authorizes the Examiner to charge or credit Deposit Account 50-0439 as necessary.

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1. REAL PARTY IN INTEREST

The present application has been assigned to Gateway, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having an office and place of business at 610 Gateway Drive, P.O. Box 2000, North Sioux City, SD 57049-2000, in an assignment recorded on November 15, 1999, (Reel /Frames: 10408/41-43).

2. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellant, Appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

Claims 1 - 30 are currently pending and are all finally rejected. These thirty claims are the subject of the present appeal (see Appendix I for a list of the claims on appeal).

4. STATUS OF AMENDMENTS

Subsequent to the Final Office Action, Appellant filed an amendment and response on September 12, 2001. In an advisory action mailed October 9, 2001, the Examiner refused entry of the proposed amendments on the grounds that new issues were presented that would require a new search. The pending claims in Appendix I do not incorporate the proposed amendments.

5. SUMMARY OF THE INVENTION

The invention describes methods and apparatuses for modifying and controlling print information. In one embodiment, a color designation for a subset of printable information units is overridden (102) for printing. Examples of printable information units include, but are not limited to, words, text, figures and drawings in a document (202, 204, 206) and/or file on a computer system. In one implementation, the color designation is changed from non-black to

black. The printable information units are then printed (104). In additional embodiments, the overriding of the color designation is based on user input and non-user input.

In an alternative embodiment, printable information units are displayed, wherein a subset of the printable information units are of a first color designation. The first color designation for this subset is then changed to a second color designation for printing. The printable information units are then sent to a printer to be printed. In another embodiment, a color of a subset of a plurality of displayed text is designated for display. The color of the subset is changed for printing. The plurality of displayed text is then sent to a printer. In yet a further embodiment, a print code is attached to a subset of printable information units, such that the print code precludes the printing of the subset. The printable information units are then sent to a printer to be printed.

6. ISSUES PRESENTED FOR REVIEW

1. Whether claims 1 and 2 were properly rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.
2. Whether claims 1-30 were properly rejected under 35 USC § 103(a) as being unpatentable over United States patent 5,809,318 to Rivette (hereinafter “Rivette”) in view of United States patent 5,751,434 to Narendranath et al. (hereinafter “Narendranath”).

7. GROUPING OF CLAIMS

The claims do not stand or fall together. For the purposes of this appeal, pending claims 1-30 will be discussed together. However, Appellant does not make any admission that any claim may not be argued in another forum as independently patentable from any other claim.

8. ARGUMENT

I) Rejections Under 35 U.S.C. §112

a) The Applicable Law

The Board of Patent Appeals and Interferences has stated that in rejecting a claim under the second paragraph of 35 U.S.C. §112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989)(citing *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970)).

The M.P.E.P. adopts this line of reasoning, stating that:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (1) The content of the particular application disclosure;
- (2) The teachings of the prior art; and
- (3) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *M.P.E.P.* § 2173.02.

b) Discussion of the Rejections

Claims 1 and 2 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. The Office Action asserts two reasons why the claims are vague, indefinite or incomplete. First, the Office Action states “[i]f the color designation is overridden (i.e. canceled) how can the next step of printing occur, absent a step of substitution of a different

color designation?" Second, the Office Action asserts that the claims are vague as to whether or not the subset is printed as part of the printable information units when printing occurs.

Appellant respectfully submits that the claim language in question, when analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the pertinent art, is not vague, indefinite or incomplete. The concept of overriding a color designation appears throughout the specification. In particular, the application disclosure, at page 6, lines 5-7, provides that "In one embodiment, the color designation for printing of the subset of the plurality of printable information units is overridden by changing a non-black color designation to a black color designation" (emphasis added). Therefore, the specification provides ample description of the term "override."

Furthermore, the teaching of the prior art provides sufficient definition for the term "override" so that the claims are not vague, indefinite or incomplete. For example, the American Heritage College Dictionary (third edition 1997) at page 975 defines the term override to include "to counteract the normal operation of (an automatic control)." In other words, an action is substituted for the action being overridden. Thus, the term overridden includes the action (substitution) that the Office Action asserts is absent.

With respect to the use of the term "subset", Appellant notes that the American Heritage College Dictionary (third edition 1997) defines subset as "[a] set contained within a set." Claims 1 and 2 specifically recite that the subset is a "subset of a plurality of printable information units" and further recites "printing the plurality of printable information units." The plain meaning of the recited language of claims 1 and 2 is that the subset is printed, because the subset is by definition a part of the plurality of printable information units.

Finally, Appellant assumes that in stating that one of ordinary skill in the art "is considered to be a clever attorney devil", the Examiner intended to establish a high degree of skill for one of ordinary skill in the art (Office Action mailed January 29, 2001, page 3). Thus, one possessing such a high degree of skill would have no difficulty in interpreting pending claims 1 and 2 in light of the specification and the prior art. As a result, one of ordinary skill in the art is able to ascertain with a reasonable degree of precision and particularity the particular

area set out and circumscribed by the claims. Therefore, Appellant respectfully submits that claims 1 and two are not vague, indefinite, or incomplete. Appellant respectfully requests that the rejection of claims 1 and 2 be reversed.

II) Rejections under 35 U.S.C. § 103

a) *The Applicable Law*

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The Examiner must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The M.P.E.P. contains explicit direction to the Examiner that agrees with the court in *In re Fine*:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). However, the level of skill is not that of the person who is an innovator but rather that of the person who follows the conventional wisdom in the art. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 474, 227 U.S.P.Q. (BNA) 293, 298 (Fed. Cir. 1985).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985). The Examiner can only rely on references which are either in the same field as that of the invention, or if not in the same field, must be "reasonably pertinent to the particular problem with which the inventor was concerned." *M.P.E.P.* § 2141.01 (a) (citing *In re Oetiker*, 24 U.S.P.Q.2d (BNA) 1443 at 1445). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Furthermore, if the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *M.P.E.P.* § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Finally, the Examiner must avoid hindsight. *Id.* The Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

b) Discussion of the Rejections

Claims 1-30 were rejected under 35 USC § 103(a) as being unpatentable over Rivette et al.(US 5,809,318) in view of Narendranath et al. (US 5,751,434). Appellant respectfully requests that the rejection be reversed, because the final Office Action fails to present a *prima facie* case of obviousness with respect to the claims. Appellant respectfully submits that the claims contain elements not found in the cited art, and that no proper motivation to combine has been proffered, nor does one exist.

Independent claim 1 recites “overriding a color designation for printing of a subset of a plurality of printable information units” (emphasis added) The final Office Action mailed June 12, 2001 refers to an “Equivalent File” and states that the file has areas “highlighted by user choice in a color different than the usual default color (black)”. The functionality attributed to Rivette does not disclose overriding (i.e. changing) the color designation to a printing color designation while leaving the display color unchanged, it merely indicates that a section of the “Equivalent File” can be highlighted in a designated color on the display. The Office Action admits that it is a display color that is being manipulated, stating that column 14, line 18 of Rivette teaches “a change or substitution of display colors” (emphasis added). The final Office Action fails to identify any section of Rivette that teaches a change or substitution of a print color such that the print color overrides, and is therefore different from, the display color. Presumably the highlighted portion would be printed in the same highlighted color as on the display, because Rivette does not teach or disclose any other way to print the highlighted section. Thus the act of highlighting is designating a color, not overriding or changing a color for printing purposes while keeping the display color unchanged.

In fact, the operation described in Rivette poses the problem that Appellant’s invention solves. In Rivette, the Equivalent file will be printed in the same color as that displayed on the monitor. For example, assume that the highlighting color designated by the user is yellow. Further assume that in order to save on color ink expenses, the user only wants the highlighting color to be displayed on a monitor, and does not wish the highlighting color to be printed when printing the highlighted section of the Equivalent File. No mechanism is disclosed in Rivette for printing the highlighted section in any color other than that designated by the user. In contrast,

Appellant's invention would provide the user in Rivette a way to maintain the highlighting on the display, while changing the designated highlighting color to a printing color.

Furthermore, the final Office Action further states that it would have been obvious "that this patent may be printed in default black using printer 57." No support for this proposition was provided in the Office Action, and no secondary reference was cited to support the statement. Per MPEP 2144.03, Appellant respectfully requested that the Examiner provide a secondary reference or an Affidavit supporting the position taken by the Examiner. No such reference or affidavit was provided to clarify or support the Examiner's statement. For the purposes of this brief, Appellant assumes that the Examiner was referring to the fact that a printer that is incapable of printing in color would print the highlighted portion in black. Appellant respectfully submits that this is not "changing the color designation to a print color designation" because there is no active overriding of a color designation for printing, the printer merely prints the document in the only color available to it.

Appellant has thoroughly reviewed Narendranath, and can find no reference to overriding and changing a designated color to a printing designation. As a result, neither Rivette nor Narendranath, alone or in combination, teach or suggest each and every element of Appellant's claims. As a result, the final Office Action fails to present a *prima facie* case of obviousness.

In addition, the final Office Action does not provide a proper motivation to combine the references. The Examiner must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*. The Office Action only states in a conclusory fashion that a laser printer could print a "PTO Image File" in black and a highlighted "Equivalent File" in multicolor. Thus the Office Action merely states a capability for a laser printer, it does not provide a specific reason why it would have been obvious to combine the references using this capability. Furthermore, the capabilities cited are not relevant to Appellant's invention as claimed, as the claims are directed to overriding a color designation for printing. The motivation to combine stated in the final Office Action merely cites the ability to print in multiple colors and does not address overriding a color designation for printing. Therefore the Office Action has not stated a proper motivation to combine. As a result,

the final Office Action fails to present a *prima facie* case for obviousness.

Claims 2 and 3 are dependent on claim 1 and provide further patentable distinctions. They are therefore non-obvious for the same reasons as discussed above regarding claim 1. Furthermore, with respect to claim 2, the Office Action states that changing from a non-black color to a black color is a design choice. Appellant respectfully disagrees. The changing of the color provides a functional benefit of saving colored ink, and is therefore more than a design choice.

Furthermore, claims 3 (and 14) recite “overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.” The Office Action asserts that Rivette, at column 3, lines 46-50 suggests the recited language because “no human intervention is required to obtain a usable equivalent file.” The cited section of Rivet in fact discusses that pagination of the Equivalent File can be achieved without human intervention. Neither the cited section nor Rivette in general state anything related to color designation independently of user input, nor does it state anything related to overriding a color designation independently of user input. Furthermore, as noted above, Narendranath does not teach or disclose overriding a color designation. Thus, the cited art, either alone or in combination, does not teach overriding a color designation independent of a user input. Therefore the rejection of claim 3 is improper and should be reversed.

Additionally, the final Office Action does not properly reject claims 12 - 14. Although the final Office Action Summary states: “Claims 1-30 are rejected,” the body of the Office Action does not reject claims 12 - 14, does not cite any references against claims 12 - 14, and does not provide any reason or statutory basis as to why claims 12 - 14 are rejected. Thus, the final Office Action fails to meet the requirements of at least:

1. 37 CFR § 1.104(a)(2): “The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant.”
2. MPEP § 707.07(d): “Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated.” (emphasis added.)
3. MPEP § 707.07(d): “The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening

sentence of each ground for rejection.” (emphasis in original.)

Appellant submits that claims 12 - 14 are allowable, and requests that the rejection of claims 12 - 14 be reversed.

Claims 4-11 and 15-30 were “by default considered obvious over the above stated art rejection in view of counsel’s admission against interest that the species claims of the invention are so closely related they cannot be properly considered independent and distinct.” These claims are allowable for the same reasons as discussed above with respect to claim 1. Reversal of the rejection of claims 4-11 and 15-30 is respectfully requested.

For all of the above reasons, Appellant respectfully requests the reversal of the rejection of claims 1-30.

9. SUMMARY

It is respectfully submitted that the pending claims are not indefinite, vague, or incomplete. Furthermore, Appellant respectfully submits that the art cited does not render the claimed invention anticipated or obvious and that therefore the claimed invention does patentably distinguish over the cited art. It is respectfully submitted that claims 1-30 should therefore be allowed. Reversal of the Examiner's rejections of claims 1-30 is respectfully requested. Should the Board be of the opinion that a rejected claim may be allowable in amended form, an explicit statement to that effect is also respectfully requested.

Respectfully submitted,
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: BOX AF, Commissioner of Patents, Washington, D.C. 20231, on this 27th day of July, 2002.

Name

Signature

APPENDIX I

The Claims on Appeal

1. A method of printing, comprising:
overriding a color designation for printing of a subset of a plurality of printable information units; and
printing the plurality of printable information units.
2. The method of claim 1, wherein overriding the color designation for printing of the subset of the plurality of printable information units includes changing for printing a non-black color designation of the subset to a black color designation.
3. The method of claim 1, wherein overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.
4. A method of printing, comprising:
displaying a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;
changing the first color designation for the subset to a second color designation for printing; and
sending the plurality of printable information units to a printer.
5. The method of claim 4, further comprising printing the plurality of printable information units.
6. The method of claim 4, wherein changing the first color designation for the subset to the second color designation includes changing from a non-black color designation for the subset to a black color designation.

7. The method of claim 4, wherein changing the first color designation for the subset to the second color designation is based on a user input.

8. A method of printing, comprising:
designating a color of a subset of a plurality of displayed text for display;
changing the color of the subset for printing; and
sending the plurality of displayed text to a printer.

9. The method of claim 8, wherein changing the color of the subset for printing includes changing from a non-black color designation of the subset to a black color designation.

10. The method of claim 8, wherein changing the color of the subset for printing is based on a user identification.

11. A method of printing a plurality of printable information units, comprising:
attaching a print code to a subset of the plurality of printable information units,
such that the print code precludes printing out the subset; and
sending the plurality of printable information units to a printer.

12. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:
overriding a color designation for printing of a subset of a plurality of printable information units; and
printing the plurality of printable information units.

13. The computer readable medium of claim 12, wherein overriding the color designation for printing of the subset of the plurality of printable information units includes changing for printing a non-black color designation of the subset to a black color designation.

14. The computer readable medium of claim 12, wherein overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.

15. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:

displaying a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;

changing the first color designation for the subset to a second color designation for printing; and

sending the plurality of printable information units to a printer.

16. The computer readable medium of claim 15, wherein changing the first color designation for the subset to the second color designation includes changing from a non-black color designation for the subset to a black color designation.

17. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:

designating a color for display of a subset of a plurality of displayed text;

changing the color for printing of the subset; and

sending the plurality of displayed text to a printer.

18. The computer readable medium of claim 17, wherein changing the color for printing of the subset includes changing from a non-black color designation of the subset to a black color designation.

19. A system, comprising:

an override module that receives a plurality of printable information units, each one of the plurality of printable information units having a color designation, and overrides the

color designation for printing of a subset of the plurality of printable information units; and
a printer, operatively coupled to the override module, that receives the plurality of
printable information units and prints the plurality of printable information units.

20. The system of claim 19, wherein the color designation is overridden from a non-black color designation to a black color designation.

21. The system of claim 19, wherein the plurality of printable information units
include a plurality of words.

22. The system of claim 19, wherein the override module overrides the color
designation independent of a user input.

23. The system of claim 19, wherein the override module overrides the color
designation based on a user identification.

24. A system comprising:

a display device that receives a plurality of printable information units and
displays the plurality of printable information units, wherein a subset in the plurality of the
printable information units has a first color designation;

an override module, operatively coupled to the display device, that receives the
plurality of printable information units and changes the first color designation of the subset to a
second color designation for printing; and

a printer, operatively coupled to the modification module, that receives the
plurality of printable information units and prints the plurality of printable information units.

25. The system of claim 24, wherein the first color designation includes a non-black
color and the second color designation includes a black color.

26. The system of claim 24, wherein the override module identifies the subset based on a user input.

27. A computer system comprising:
a computer having a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;
a display device operatively coupled to the computer and capable of displaying the printable information units; and
an override module located in the computer, comprising machine readable instruction for causing the computer to perform a method including changing the first color designation for printing of the subset to a second color designation.

28. The computer system of claim 27, wherein the override module further comprises machine readable instructions for causing the computer to include sending the plurality of displayed text to a printer.

29. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation independent of a user input.

30. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation based on a user identification.



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APPELLANTS' BRIEF ON APPEAL

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